



Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

5

Application Number 09/578,085

Filing Date May 24, 2000

First Named Inventor Palmeri, Richard

Art Unit 3628

Examiner Name Poinvil, Frantzy

Attorney Docket Number 1029-03

### ENCLOSURES (Check all that apply)

<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input checked="" type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation	<input type="checkbox"/> Status Letter
<input checked="" type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Change of Correspondence Address	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Reply to Missing Parts/ Incomplete Application	<input type="checkbox"/> Landscape Table on CD	
<input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53		

Remarks

Check in the amount of \$225 for a two month extension of time.

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Frank A. Cona		
Signature			
Printed name	Frank A. Cona		
Date	July 13, 2006	Reg. No.	38,412

### CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature			
Typed or printed name	Frank A. Cona	Date	July 13, 2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit : 3628  
Examiner : Poinvil, Frantzy  
Serial No. : 09/578,085  
Filed: : May 24, 2000  
Inventor : Richard Palmeri  
Title : SYSTEM FOR ELECTRONIC  
: RE-ALLOCATION OF A  
: TRANSACTION AMOUNT TO  
: AN INVESTMENT

Docket: 1029-03

Dated: July 13, 2006

---

**RESPONSE**

Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is in response to the Official Action dated February 13, 2006.

We greatly appreciate the withdraw of the Kalina reference.

We respectfully submit that solicited Claims 30-58 are patentable over the newly cited reference, Burke (U.S. Patent No. 5,621,640) in view of the previously cited and overcome reference, Hartt et al (WO 94/04979)..

We respectfully note that the Burke reference is merely duplicative of the previously cited references. All that these cited references disclose are prior systems for electronic purchases and the benefit of providing rebates. But none teach or suggest the claimed system for the electronic re-allocation of a transaction amount to an investment.

As the Examiner admits, the Burke reference fails to disclose the **electronic** transfer of funds to the trust, which, from early on, has been stressed as an important distinguishing aspect of the claimed invention (albiet not the only one) over the prior art. And, as acknowledged two years ago in withdrawing the prior rejection over Hartt, Hartt et al do not disclose, teach, or suggest this either.

As stated in the Applicant's response filed on June 14, 2004 (and the apparent basis upon which the Examiner withdrew the Hartt rejection at that time), "Hartt et al. do not teach or suggest electronically receiving at least a portion reallocated from the transaction amount from

the vendor to the user account. In Hartt et al., the subscriber transaction information is transferred after the transaction, such as by using written records, magnetic files, or electronic data transfer. Thereafter, the processor calculates the rebate amount and has these funds transferred to the investment. (Page 3, lines 1-21.)

However, Hartt et al. are silent as to how the transaction amount is passed from the subscriber (user) to the vendor, and from the vendor to the escrow account. In sharp contrast to Hartt et al. the claimed invention electronically reallocates a portion of the transaction amount to the investment proximate in time to the transaction. This is not taught or suggested in the Hartt reference."

Thus, even hypothetically combining these references still fails to teach or suggest the claimed invention. One of ordinary skill would still need some suggestion in the references to further modify them to achieve the claimed invention.

As previously explained, the claimed invention is a complete system for the electronic re-allocation of a transaction amount to an investment, which electronically distributes at least a portion reallocated from the transaction amount from the user account to the vendor account and electronically distributes the portion reallocated from the transaction amount from the vendor account to the user trust account, and places it in a user investment vehicle for the user.

As admitted by the Examiner, this electronic process for the re-allocation of funds is simply not disclosed, taught, or suggested in either cited reference – either alone or in combination. We respectfully note that it is the claimed invention as a whole that must be considered, not the aspect of adding the ability to conduct electronic transfers to the trust or investment vehicle. Even so, neither reference teaches or suggests the claimed electronic system or even that one element and neither reference itself provides any suggestion that they should be combined and then further modified for such complete electronic transfer. This is irrespective of the hypothetical motivation provided by the Examiner.

Accordingly, we respectfully submit that there is no *prima facie* obviousness and respectfully request that the rejection under 35 U.S.C. 103(a) be withdrawn.

We respectfully note that this application was filed over six years ago on May 24, 2000, and has been subject to at least five non-final office actions. The current claims have been subject to three non-final office actions. And now, yet another new reference, the Burke

reference, is being cited and is being combined with the Hartt reference, which was previously acknowledged not to teach or suggest the claimed invention.

As expressly stated in MPEP 707.07(g), piecemeal examination should be avoided as much as possible. As also noted in MPEP 707.02, any application that has been pending five years should be carefully studied by the examiner and **every effort** should be made to terminate its prosecution. In order to accomplish this result, **the application is to be considered "special" by the examiner.**

While we appreciate the Examiner's motivation to be thorough in searching and examining this case, we respectfully submit that after six years, five non-final office actions, and four responses on these claims, that this application is ripe for disposition.

For the reasons set forth above, we respectfully submit that that disposition should be a prompt notice of allowance, which action is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Frank Cona". The signature is written in a cursive, flowing style.

Frank A. Cona  
Reg. No. 38,412